

REMARKS

The Office Action dated April 19, 2006, and the references cited therein have been carefully considered. Claims 1-27 are presently pending. No claims currently stand allowed. Applicants have amended claims 1, 13 and 17 to clarify the separate and distinct nature of an on-line advertisement and an on-line survey solicitation that is selectively invoked by further instructions added to a block of data that contains the on-line advertisement. The de Ment patent, on the other hand, merely discloses an invitation to take a survey (which is not the same as Applicants' disclosed and claimed on-line advertisement). In view of the claim amendments and remarks set forth herein below, the pending claims 1-27 are patentable over the prior art presently known to Applicants. Accordingly, Applicants request favorable reconsideration of the grounds for the previous rejection in view of the now pending claims. Please charge any fee deficiencies to Deposit Account No. 12-1216.

Summary of the Grounds for the Prior Art Rejections

1. **Sections 2 and 3:** Claims 1-7, 10-11, and 13-21 are rejected under 35 U.S.C. §102(e) as being anticipated by de Ment U.S. Pat. No. 6,728,755 (filed on September 26, 2000), hereinafter "the de Ment '755 patent";
2. **Sections 4 and 5:** Claims 8-9 and 22-24 are rejected under 35 U.S.C. §103(a) as being obvious over the de Ment '755 patent in view of Hamlin et al. U.S. Patent No. 6,477,504, hereinafter "the Hamlin '504 patent"; and
3. **Section 6:** Claims 12 and 25-27 are rejected under 35 U.S.C. §103(a) as being obvious over the de Ment '755 patent.

Applicants traverse each and every rejection of the presently pending claims over the prior art for at least the reasons set forth herein below.

Detailed Remarks Responding To Prior Art Rejections

Applicants traverse the rejection, in sections 2 and 3 of the Final Office Action, of claims 1-7, 10-11, and 13-21 under 35 U.S.C. §102(e) as being anticipated by the de Ment '755 patent. Applicants' amendments to the independent claims directly address a clarity issue/concern raised in the "Response to Arguments" section of the Final Office Action. In particular, the last paragraph on page 13 states "Based on the claim language, it appears that the advertisement is calling a user's attention to the survey (i.e. the advertisement is making

the user aware of the survey)." As Applicants have disclosed in an embodiment of their invention described in paragraphs 17-19 of their published application, the on-line advertisement and on-line survey solicitation are separate and distinct entities. In response to the clarity issue raised at page 13 of the Office Action, Applicants' have amended each of the independent claims to unequivocally distinguish the recited on-line advertisement and on-line survey solicitation. In addition to specifically reciting this distinction, Applicants have also specified in the "adding" step that the instructions for deciding whether to present the on-line survey solicitation are, in fact, added to the block of data that already includes the computer-readable instructions for presenting the on-line advertisement. Applicants note that the recited sequence of steps recited in claim 1 is described in FIG. 1 and paragraphs 18 and 19 of Applicants' published application US 2003/0009372. While the previously presented independent claims arguably contain sufficient language to distinguish the recited on-line advertisement from the on-line survey solicitation, the current amendments make this distinction unequivocal.

There does not appear to be any question regarding the disclosure of the de Ment patent with regard to on-line advertisements and on-line surveys. The de Ment '755 patent discloses a survey management facility wherein a pop up survey is submitted to a user based upon the results of a criterion implemented by a routine (see, step/pop-check routine 210) invoked when a user invokes a *web tool* (see, step 205 of FIG. 2). In response to the user invoking a web tool, the pop-check routine is executed to determine whether to launch a pop-up survey. During step 212 a kill switch enables inactivation of the pop-up survey for a period of time. During step 216, the pop-check routine checks a cookie on the user's computer to see whether the user has seen the *survey* in the last six months. The cookie in de Ment indicates whether the survey has been executed on the computer. In contrast to the invention recited in Applicants' pending claim 3, the cookie disclosed in de Ment does not specify when a *solicitation to take the survey* was last presented on the computer. Thus, de Ment, lacking this additional element recited in claim 3, is incapable of determining whether a user has been recently solicited and refused to take the survey.

Applicants specifically traverse the rejection of **claim 1** as anticipated by the de Ment '755 patent. Claim 1 includes multiple elements that are not disclosed in the de Ment '755 patent. Claim 1 recites an "on-line advertisement" presented in accordance with computer-readable instructions contained in a block of data requested from an ad server, to which

additional code is added for determining whether to present an on-line survey solicitation that is separate and distinct from the on-line advertisement. The de Ment '755 patent does not disclose any such modified advertisement code block. Applicants' specification and present claims make clear the distinction between an on-line advertisement and an on-line survey solicitation. The separate recitation of advertisement code and the added code for determining whether to present an on-line survey solicitation precludes applying the disclosure of de Ment in the way described in the Final Office Action.

Applicants traverse the rejection of claim 1 for at least the additional reason that de Ment does not disclose the recited "accessing" step. In particular, the "accessing" step specifically recites "accessing information regarding previous presentation by the browser client of *the on-line survey solicitation*" – the invitation to a user to take the survey. There is no dispute that the de Ment '755 patent discloses accessing information regarding whether or not the user has previously *taken the actual survey*. Thus, step 216 of the de Ment '755 patent addresses assuring that a particular survey is not carried out for a period of time after completing the survey. Step 216 does not address limiting repetition of survey solicitation after a previous *solicitation* is presented to a user/computer. For at least this further reason claim 1 is not anticipated by the de Ment '755 patent.

Applicants traverse the rejection of independent **claims 13 and 17** for at least the reasons set forth above regarding claim 1. Applicants traverse the rejection of claim 14 for at least the reasons provided above with regard to claim 1.

The rejection of **claim 2** is also traversed since the claimed accessing and adding steps are not even disclosed in de Ment.

Applicants traverse the rejection of **claims 3 and 4** since, as noted above, the de Ment '755 patent does not disclose receiving cookie data indicative of the on-line survey *solicitation*. Rather it discloses a cookie that indicates whether *an on-line survey itself* was presented on a client computer.

Applicants traverse the rejection of **claim 5**. Applicants have clarified their recited invention by expressly indicating the block of data sent to the browser client includes the *added computer-readable instructions*.

Applicants traverse the rejection of claims **6, 7, 10** for at least the reasons set forth for claim 1 from which these claims depend.

Applicants traverse the rejection of claims **11 and 16** for at least the reason set forth for claim 1. Applicants note that claim 11 specifically references an on-line *advertisement* which is not disclosed in the de Ment patent.

Applicants traverse the rejection of **claim 15**. The claim recites inserting script into a downloaded advertisement. However, this aspect of the recited invention is not disclosed in the de Ment '755 patent.

Applicants traverse the rejection of **claim 18** since de Ment patent does not disclose determining when the *solicitation* was last executed on the client.

Applicants traverse the rejection of **claim 19** for at least the reasons set forth above for claim 1 (and claim 13 by reference).

Applicants traverse the rejection of claims **20 and 21** for at least the further reason that the de Ment patent does not disclose attaching script to an on-line advertisement

Applicants traverse the rejection, in sections 4 and 5 of the Office Action, of claims **8-9 and 22-24** under 35 U.S.C. §103(a) as being obvious over the de Ment '755 patent in view of the Hamlin '504 patent. Neither de Ment nor Hamlin discloses a *frequency parameter value* being a function of *time remaining/elapsed* in a campaign.

Applicants traverse the rejection, in section 6 of the Office Action, of **claims 12 and 25-27** under 35 U.S.C. §103(a) as being obvious over the de Ment '755 patent. Regarding the rejection of claim 12, Applicant notes that in the rejection of claim 12, the Final Office Action appears to assert that the recited invention concerns "an advertisement for a survey". Applicants note that their invention is directed to providing a solicitation to take a survey in association with a downloaded advertisement. This distinction has been clarified in the presented amendments to each of the independent claims. The de Ment '755 patent does not disclose providing a survey solicitation in association with an on-line advertisement and thus cannot render any of the pending claims, including claim 12, unpatentable.

Applicants traverse the rejection of claims 25-27 as obvious over de Ment. In particular, de Ment neither discloses nor suggests an ad server. In fact, the methods/system disclosed in de Ment do not even concern on-line advertisements.

Conclusion

For the above reasons, the above-amended claims are in proper form for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Mark Joy, Reg. No. 35,562
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: August 17, 2006

211367 RCE ROA